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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,197	10/20/2000	Hideaki Yamanaka	198480US2	5849

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

RHODE JR, ROBERT E

ART UNIT PAPER NUMBER

3625

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,197

Inventor(s)

YAMANAKA ET AL.

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant amendment of 12-23-04 amended claims 1 - 14 as well as traversed rejections of Claims 1 – 14 and withdrew claims 15 - 28.

Currently, claims 1- 14 are pending.

Claim Objections

Claims 1 – 14 are objected to because of the following informalities: The applicant continually uses the word “making”, which in certain steps the word “making” is not the most appropriate choice of a verb for every step and much less in every claim. For example in the body of claim 1, “making” a consumer is at best awkward – since one cannot “make” a consumer do anything. In this context, “making” could be changed to “having”. The applicant is encouraged to ensure appropriate translation of the word “making” to more appropriate words through out all claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 – 6, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austin (US 6,157,924) in view of Egawa (US 5,745,694).

Regarding claim 1, the combination of Austin and Egawa teach a digital content downloading method using a network in which digital content is downloaded, comprising the steps of:

Where Austin teaches making a consumer send both information designating a desired digital content selected by the consumer and a desired digital content transmission condition selected by the consumer to a digital content retailer possessing the desired digital content through a network (see at least Abstract and Figures 6A-D); making the digital content retailer download the desired digital content designated by the information to the consumer through the network reserved by the digital content retailer at the desired digital content transmission condition/sent from the consumer (see at least Col 2, lines 27 – 62). Regarding claim 3, Austin teaches a digital content downloading method using a network, wherein the network is composed of a plurality of networks managed by a plurality of network operators, and the desired digital content transmission condition selected by the consumer corresponds to a communication quality of each of the networks (Figure 6D) and (4) wherein the communication quality of each network is determined by one of a data transfer rate, a delay time, a delay variation, a burst size, a cell interval and a cell discard rate (Col 2, lines 45 – 49 and Figure 6D).

However, Austin does not specifically disclose and teach making the digital content retailer reserve the network managed by a network operator according to the desired digital content transmission condition sent from the consumer; and making the digital content retailer collect a charge for the desired digital content, in which a transmission charge corresponding to the desired digital content transmission condition is included, from the consumer; and making the digital content retailer pay the transmission charge to the network operator.

On the other hand, Egawa discloses and teaches a making the digital content retailer reserve the network managed by a network operator according to the desired digital content transmission condition sent from the consumer (see at least Abstract and Col 1, lines 46 – 64);

making the digital content retailer collect a charge for the desired digital content, in which a transmission charge corresponding to the desired digital content transmission condition is included, from the consumer; and making the digital content retailer pay the transmission charge to the network operator.

Please note that Egawa does not specifically disclose collecting a charge and including the charge as well as making the content provider pay for the transmissions -although it is implicit. Furthermore, it is old and well known that content providers do have this charge back mechanism to charge for the services reserved and used for the delivered content as well as paying the network operator. An example is the patent to Reisman (US 6,594,692) [Col 60, lines 6 – 39]. Moreover,

regarding claim 2, Egawa teaches a digital content downloading method using a network, wherein the desired digital content transmission condition selected by the consumer is a transmission time condition such as an urgent transmission condition, a date and time specifying transmission condition or a date specifying transmission condition (Col 4, lines 54 – 57).

regarding claim 5, Egawa teaches a digital content downloading method using a network, wherein a bandwidth of the network is reserved with a time condition in the network reservation according to the desired digital content transmission condition (Col 1, lines 56 – 60).

regarding claim 6, Egawa teaches a digital content downloading method using a network, wherein the desired digital content transmission condition selected by the consumer is a bandwidth guarantee type transmission condition, in which a transmission time period is guaranteed, or a bandwidth no-guarantee type transmission conditions, in which a transmission time period is not guaranteed, and the transmission charge is heightened as the transmission time period is shortened (Col 5, lines 4 – 8).

regarding claim 9, Egawa teaches a digital content downloading method using a network, wherein the step of making the digital content retailer download the desired digital content includes:

making the digital content retailer send a transmission start notice to the consumer before the downloading of the desired digital content;

making the network operator manage a transmission time period in the transmission of the desired digital content 30 until the digital content retailer sends a transmission completion notice to the network operator;

making the network operator send a time-out notice to the digital content retailer in cases where the transmission time period exceeds a prescribed value; and

making the digital content retailer forcibly terminate the downloading of the desired digital content in cases where the digital content retailer receives the time-out notice from the network operator (see at least Abstract and Col 4, lines 54 – 58).

regarding claim 13, Egawa teaches a digital content downloading method using a network, wherein the step of making the digital content retailer download the desired digital content includes:

making the consumer send a reception impossible notice to the digital content retailer in cases where the consumer fails in receiving the desired digital content;

making the digital content retailer send a transmission termination notice to the network operator; and

making the digital content retailer send a transmission no-completion notice to the consumer (see at least Abstract and Figure 3A).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Austin with the method of Egawa to have enabled a digital content downloading method using a network in which digital content is downloaded, comprising the steps of: making a consumer send both information designating a desired digital content selected by the consumer and a desired digital content transmission condition selected by the consumer to a digital content retailer possessing the desired digital content through a network; making the digital content retailer reserve the network managed by a network operator according to the desired digital content transmission condition sent from the consumer; making the digital content retailer download the desired digital content designated by the information to the consumer through the network reserved by the digital content retailer at the desired digital content transmission condition/sent from the consumer; making the digital content retailer collect a charge for the desired digital content, in which a transmission charge corresponding to the desired digital content transmission condition is included, from the consumer; and making the digital content retailer pay the transmission charge to the network operator – in order provide the capability for a consumer regardless of communications networks to order and obtain digital content . In this manner, the consumer is relieved of all the old needs to establish the correct network connections for digital content and thereby will increase their satisfaction. With this increased satisfaction, the probability that they will return for additional ordering as well recommending the method to others.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Austin and Egawa as applied to claim 1 above, and further in view of Reisman (US 6,594,692 B1).

The combination of Austin and Egawa substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach a digital content downloading method using a network, wherein the step of making the digital content retailer download the desired digital content includes:
making the digital content retailer check through the network whether or not the consumer has a capability such as a memory capacity for receiving the desired digital content, before the desired digital content is downloaded to the consumer at the desired digital content transmission condition.

On the other hand and regarding Claim 7 (Currently Amended), Reisman teaches a digital content downloading method using a network, wherein the step of making the digital content retailer download the desired digital content includes:
making the digital content retailer check through the network whether or not the consumer has a capability such as a memory capacity for receiving the desired digital content, before the desired digital content is downloaded to the consumer at the desired digital content transmission condition (Col 16, lines 40 – 42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Austin and Egawa with the method of Reisman to have enabled a digital content downloading method method using a network, wherein the step of making the digital content retailer download the desired digital content includes: making the digital content retailer check through the network whether or not the consumer has a capability such as a memory capacity for receiving the desired digital content, before the desired digital content is downloaded to the consumer at the desired digital content transmission condition – in order to enable the checking of user method capacity. In this manner, the accuracy of the method will be increased through ensuring that the consumer has the capability to store the content, which will increase consumer satisfaction. Indeed, the consumers increased satisfaction will increase the probability that they will recommend the service to others.

Claims 8, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Austin and Egawa as applied to claim 1 above, and further in view of Bernard (US 5,918,213).

The combination of Austin and Egawa substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach a digital content downloading method using a network, wherein it includes connecting a consumer to a network composed of telephone line or coaxial cable, sending personal information such as payment information, charging the consumers credit card with authentication as well as sending the credit charges for the content to the credit company and having the credit card company send a bill.

On the other hand and regarding claim 8, Bernard teaches a digital content downloading method using a network, wherein the step of making the digital content retailer download the desired digital content includes: connecting the consumer to the network through a subscriber line which is composed of a telephone line, an optical fiber cable, a coaxial cable or a radio transmission line (see at least Abstract and Figures 4 – 8) and regarding claim 11, Bernard teaches a digital content downloading method using a network, wherein the step of making the consumer send both the information and the making the consumer send personal information and payment information of the consumer to the digital content retailer (Col 10, lines 44 – 45 and Figure 12); making the digital content retailer inquire of a credit company whether or not the personal information and the payment information sent from the consumer is correct (Col 10, lines 44 – 45); making the credit company perform the authentication of the consumer according to the personal information and the payment information (Col 10, lines 44 – 45); and making the credit company send an authentication notice to the digital content retailer in cases where the personal information and the payment

information is correct (Col 10, lines 61 - 67). Please note that Bernard does not specifically address each step such as authentication by the credit card company. However, these steps are implicit and were old and well known for online shopping sites (see Chelliah (US 5,710,887). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Bernard with these capabilities to ensure credit worthiness of shoppers – before consummating the sale. In addition and regarding claim 12, Bernard teaches a digital content downloading method using a network, wherein the step of making the digital content retailer collect a charge for the desired digital content includes: making the digital content retailer send an accounting notice corresponding to the charge for the desired digital content to a credit company; making the credit company send a bill, which corresponds to the charge for the desired digital content, to the consumer in response to the accounting notice; making the consumer pay the charge for the desired digital content to the credit company in response to the bill; and making the credit company pay the charge paid by the consumer to the digital content retailer (Col 2, lines 11- 12). Please note that the steps required to implement a credit approval and billing method were old and well known at the time of the applicant's invention. Therefore, it would have been obvious to provide a credit approval and billing method in order to ensure payment. Regarding claim 14, Bernard teaches a digital content downloading method using a network, wherein the desired digital content is a music file, a video file or a game software title (Figure 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Austin and Egawa with the method of Bernard to have enabled a digital content downloading method using a network, wherein it includes connecting a consumer to a network composed of telephone line or coaxial cable, sending personal information such as payment information, charging the consumers credit card with authentication as well as sending the credit charges for the content to the credit company and having the credit card company send a bill – in order to implement a complete e-commerce method. In this manner, the entire transaction is handled by the method – with consumer input and thereby ensures a complete transaction for obtaining as well as paying for the content by the consumer. As a result, the method will ensure that the retailer and network operator are paid for the services rendered as well as enabling the consumers complete steps, which will increase their satisfaction as result of quickly and easily obtaining the content.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bernard and Reisman as applied to claim 1 above, and further in view of Spagna (US 6,587,837 B1).

The combination of Austin and Egawa substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach a digital content downloading method using a network wherein the step of making the digital content retailer download the desired digital content includes: making the digital content retailer cipher the desired digital content; making the digital content retailer download ciphered data of the desired digital content; and making the consumer decipher the ciphered data of the desired digital content to obtain the desired digital content.

Regarding claim 10, Spagna teaches a digital content downloading method using a network wherein the step of making the digital content retailer download the desired digital content includes: making the digital content retailer cipher the desired digital content; making the digital content retailer download ciphered data of the desired digital content; and making the consumer decipher the ciphered data of the desired digital content to obtain the desired digital content (see at least Col 3, lines 27 – 29 and Figures 1A – C).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Bernard and Reisman with the method of Spagna to enable a digital content downloading method using a network wherein the step of making the digital content retailer download the desired digital content includes: making the digital content retailer cipher the desired digital content; making the digital content retailer download ciphered data of the desired digital content; and making the consumer decipher the ciphered data of the desired digital content to obtain the desired digital

content – in order to ensure secure transmission of the digital content, which often contains proprietary information. In this manner, the sender and receiver of the digital content will be assured that only the desired recipient will be able to decrypt the information and thereby protect the digital contents from unauthorized use. This will increase the consumer's confidence in the service, which will increase the probability that they will continue to use the service in the future.

Response to Arguments

Applicant's arguments, see Paper No. 9, filed 12/23/2003, with respect to the rejection(s) of claim(s) 1 - 14 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Austin (US 6,157,924) and Egawa (US 5,745,694).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 703.308.3588. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER


Jeffrey A. Smith
Primary Examiner